REMARKS

Reconsideration and removal of the grounds for rejection are respectfully requested. Claims 1-21 were cancelled and claims 22-41 were previously presented.

The applicant respectfully requests that the finding of finality be withdrawn, as the final office action represents the first examination on the merits of the applicants' claims and so the issue as to the patentability of the claims has not yet been clarified. As discussed in MPEP 706.07:

> "Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. ...."

This is the first opportunity applicant has to address the prior art rejection, yet because this is a final rejection, the applicant has no opportunity to amend the claims in response. Withdrawing the finality of the rejection will give the Examiner, and the applicant, one more opportunity to clarify the issues before appeal.

The Examiner has rejected claims 22-41 as being obviousness over Matsumoto et al. (US 2001/00265545) in view of Thorton et al. (U.S. Patent no. 6,363,065).

In order to uphold a finding of obviousness, there must be some teaching, suggestion or incentive for doing what the applicant has done. ACS Hospital Systs. Inc. v. Montefiori Hospital, 723 F.2d 1572 (Fed. Cir. 1984). Also, "Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure." In re Dow Chemical Co., 837 F.2d 469 (Fed. Cir. 1988).

The applicants' invention relates to a method for controlling telephone connections for internet protocol communications by providing a message protocol. Messages are used to facilitate communication between an IP phone and an Ethernet PBX, with the invention

providing a message template that "wraps" the messages communicated between the IP phone and the PBX. (p. 3, l. 6-8) The message template is added to each message generated, comprising a Protocol Header that includes a Prototype indicator, a Device Number indicator, and a message type indicator.

Matsumoto describes a method of registering an IP terminal device to a PBX wherein the IP terminal device is registered as a radio telephony device in a database of the PBX. By registering the IP terminal device as a radio telephony device in the database, the device can receive a variety of supplementary services provided by the PBX. Moreover, registration of the IP terminal device as a radio telephony device allows for moving the IP terminal device from one location to another without updating the PBX.

Thorton discloses a telephony gateway which, when operated with a similar peer Gateway and each being connected at opposite ends of the Public Switched Telephone Network (PSTN) and IP data network, dynamically switches a call alternately between the data network and the PSTN based on real-time measurements of quality of service associated with the data network.

The Examiner has admitted that Matsumoto does not teach encapsulation of the message as recited in claim 1, citing Thorton as teaching "encapsulating said message with a Protocol Header and an IP message body, wherein the Protocol Header includes an indication of Protocol Type for denoting whether the message is an IP message or an encapsulated non-IP message, a Device Number for denoting by means of MAC (Media Access Control) an address within said PBX to which said message is to be transmitted or from which said message is to be received, and Message Type for identifying the type of message contained in the IP Message Body".

However, the Examiner is incorrect in his reading of this patent. While Thorton teaches encapsulating data into IP packets, there is no teaching or suggestion of the use of a Protocol type

indicator within a protocol header. While "message type" and a "device number" may arguably be disclosed, neither patent even suggests that a Protocol header could or should include protocol type information.

According to the present invention, as defined by independent claim 22, a method is provided for communication between an IP phone and a network-implemented PBX. A broad aspect of the invention is encapsulation of this message with a Protocol Header and an IP Message Body. However claim 22 is more specific and requires within the Protocol Header, an indication of Protocol Type for denoting whether the message is an IP message or an encapsulated non-IP message. This aspect of the invention is important for identifying which of multiple messaging protocols is contained within the encapsulated message (i.e. an IP message or a non-IP (e.g. legacy-PBX) message). By defining the Protocol Type within the Protocol Header, call control functionality from legacy-PBX systems may be extended to an Ethernet or LAN-implemented PBX. Matsumoto et al. and Thorton are completely silent as to this claimed feature, and so neither Matsumoto et al. nor Thorton teach or suggest such an inclusion. Consequently claims 21-42 are not obvious in view of the proposed combination of references.

Based on the above amendments and remarks, favorable consideration and allowance of the application are respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

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